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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/828,870	04/20/2004	Michael E. Hirsch	196209 (8287-69US)	5620

23973 7590 11/01/2005

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EXAMINER

REHM, ADAM C

ART UNIT	PAPER NUMBER
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2875

DATE MAILED: 11/01/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

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Office Action Summary	Application No. 10/828,870	Applicant(s) HIRSCH ET AL.	
	Examiner Adam C. Rehm	Art Unit 2875	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-14 is/are pending in the application.
 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1-14 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 20 April 2004 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
 a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. ____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. ____. |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date <u>11/1/2004</u> . | 6) <input type="checkbox"/> Other: ____. |

DETAILED ACTION

Drawings

1. The drawings are objected to under 37 CFR 1.83(a). The drawings must show every feature of the invention specified in the claims. Therefore, the arcuate slot per Claim 7 must be shown or the feature(s) canceled from the claim(s). No new matter should be entered.

Corrected drawing sheets in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. The figure or figure number of an amended drawing should not be labeled as "amended." If a drawing figure is to be canceled, the appropriate figure must be removed from the replacement sheet, and where necessary, the remaining figures must be renumbered and appropriate changes made to the brief description of the several views of the drawings for consistency. Additional replacement sheets may be necessary to show the renumbering of the remaining figures. Each drawing sheet submitted after the filing date of an application must be labeled in the top margin as either "Replacement Sheet" or "New Sheet" pursuant to 37 CFR 1.121(d). If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

2. Claims 1, 9 and 11-14 are rejected under 35 U.S.C. 102(b) as being anticipated by VOLZ (US 5,286,216), which discloses a fluorescent adapter (Fig. 2 generally) comprising:

- A housing (32) including a tip contact (64) compatible with an electrical socket (10);
- A ring contact compatible with the electric socket, the ring contact threadedly engaging and surrounding the housing and freely rotatable with and relative to the housing when the housing is rotated in a first direction and not rotatable with the housing when the housing is rotated in an opposite direction (36, Column 4, Line 58-Column 5, Line 17 provides a threaded configuration wherein a ring has a slot matable with a corresponding housing projection); and
- A fluorescent ballast (34) supported by the housing and having input electrodes/contact pins (80) in electrical contact with the tip contact and the ring contact, respectively, and output electrodes/key slots for removably receiving the contact pins of a fluorescent lamp (74 being keyed to the contact pins).

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

3. Claim 2 is rejected under 35 U.S.C. 103(a) as being unpatentable over VOLZ (US 5,286,216) as applied to claim 1 above, and further in view of YAN (US 6,494,730). VOLZ discloses the claimed invention, but does not disclose a drive member on the housing for engaging the ring contact when the housing is rotated in the first direction during insertion of the adapter into the electrical socket and for disengaging from the ring contact when the housing is rotated in the opposite direction. However, YAN teaches a lamp socket insert (300) wherein a lamp screw base/housing is rotated in a first direction to engage the insert and in an opposite direction to disengage (Fig. 1, Column 4, Lines 36-41) for the purpose of providing theft deterrence (Column 2, Lines 64-67). It would have been obvious to one of ordinary skill in the art at the time of invention to modify VOLZ and use the insert as taught by YAN in order to provide additional theft-deterrent means.

4. Claim 3 is rejected under 35 U.S.C. 103(a) as being unpatentable over VOLZ (US 5,286,216) as applied to claim 1 and YAN (US 6,494,730) as applied to claim 2 above. VOLZ and YAN disclose the claimed invention, but do not disclose a drive member integrally molded into the housing. However, it would have been obvious to

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one of ordinary skill in the art at the time the invention was made to make the parts integral for ease of assembly, since it has been held that forming in one piece an article which as formerly been formed in two pieces and put together involves only routine skill in the art. *Howard v. Detroit Stove Works*, 150 U.S. 164 (1893).

5. Claims 4-8 are rejected under 35 U.S.C. 103(a) as being unpatentable over VOLZ (US 5,286,216) as applied to claim 1 and YAN (US 6,494,730) as applied to claim 2 above, and further in view of SANTOPIETRO (US 4,750,892). VOLZ and YAN disclose the claimed invention, but do not disclose (a) a tooth for engaging the ring contact when the housing is rotated in the first direction (Claim 4); (b) an opening/arcuate slot for receiving the tooth when the housing is rotated in the first direction (Claims 5 and 7); (c) the combination thereof (Claim 6). However, SANTOPIETRO teaches a fluorescent lamp adapter having teeth/pawls (157) and corresponding holes (154) for the purpose of providing an adapter that can be installed without a tool to provide a "one-way clutch" or unidirectional drive means (Column 7, Lines 39-56). It would have been obvious to one of ordinary skill in the art at the time of invention to modify VOLZ and YAN and use the teeth and holes as taught by SANTOPIETRO for ease of installation.

6. Regarding Claim 7, which is directed to an arcuate-shaped hole, more than a mere change of form is necessary for patentability. *Span-Deck Inc. v. Fab-Con, Inc.* 215 USPQ 835. It would have been obvious to design and shape holes that better correspond to the teeth and design choice thereof.

7. Claim 10 is rejected under 35 U.S.C. 103(a) as being unpatentable over VOLZ (US 5,286,216) as applied to claim 9 above, and further in view of MATSUBA ET AL. (US 6,736,526). VOLZ discloses the claimed invention, but does not disclose an enclosure removably attached to the ballast for enclosing the fluorescent lamp. However, MATSUBA teaches a globe (10) for the purpose of providing an improved external appearance (Column 2, Lines 31-34). It would have been obvious to one of ordinary skill in the art at the time of invention to modify VOLZ and use the globe as taught by MATSUBA for aesthetic purposes.

Conclusion

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

8. UGALDE (US 4,936,789) discloses an apparatus for preventing theft of a fluorescent lamp and ballast.

9. HARADEN (US 4,624,513) discloses a lamp holder assembly having a disk portion, a ring portion and a housing portion.

10. ENGEL (US 4,623,823) discloses an electric adapter assembly enabling the use of fluorescent lamps and providing a security feature.

11. NORTON (US 3,467,937) discloses a lamp socket insert.

Correspondence

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Adam C. Rehm whose telephone number is 571.272.8589. The examiner can normally be reached on M-F 9-5:30 EST.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Sandra O'Shea can be reached on 571.272.2378. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

ACR
10/21/2005


ALAN CARIASO
PRIMARY EXAMINER